

REMARKS

This Reply is in response to the Office Action mailed on May 29, 2007 in which Claims 1-8, 10-16, 18-23 and 25-35 were rejected. With this response, claims 1 and 2 are amended. For the reasons which follow, the rejection of claims 1-8, 10-16, 18-23 and 25-35 should be withdrawn. Accordingly, Applicants respectfully request reconsideration and allowance of the present application.

I. Examiner Interview Summary

On August 27, 2007, a telephonic interview was held between Examiner Meucci and Applicants attorney, Todd A. Rathe. The rejection of the claims under 35 USC 112, first paragraph was discussed. Although no agreement reached, Applicants wish to thank the Examiner for the opportunity discussed the rejection.

II. Objection to the Specification

Section 3 of the Office Action object to specification asserting that the reference character "14" is used to designate both a "hard copy output engine" and a "peripheral device" when referring to figure 1.

In response, the Specification is amended to use reference character "14" when only referring to a "hard copy output engine". The Specification is further amended to clarify that the hard copy output engine is one form of a peripheral device.

Section 4 of the Office Action objected to specification as allegedly failing to provide proper antecedent basis for the term "computer usable medium." In particular, the Office Action asserted that the Specification does not define the term "computer usable medium" in claims 21-23, 25 and 26.

In response, the Specification is amended to add the term "computer usable medium" when describing various forms of computer usable medium. Since the term "computer usable medium" was part of the originally filed claims, no new matter

is added. Accordingly, Applicants respectfully request that the objection to the Specification be withdrawn in light of such amendments.

III. Rejection of Claims 8 and 10-13 under 35 USC 112, First Paragraph

Section 6 of the Office Action rejected claims 8 and 10-13 under 35 USC 112, first paragraph. In particular, the Office Action asserted:

the specification, while being enabling for the "device" as a database maintained by the vendor, does not reasonably provide enablement for non-vendor-maintain databases, intermediate transmission media in a network, and other computer systems in which the signal originates. The specification does not enable any person skilled in the art to which pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with the claims. Since the claims defined the apparatus as a device, any device configured to provide, transmit, or relay a signal (e.g. databases not maintained by the vendor, home computers, gaming consoles, cellular phones, modems, etc.) would embody the applicant's invention as claimed.

(Office Action dated May 29, 2007, pgs. 2-3).

Applicants respectfully traverse the rejection. 35 USC 112, first paragraph provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In the present case, the specification meets each of these requirements for the invention set forth in claims 8 and 10-13. Claim 8 recites a device configured to provide a computer instruction signal that when executed by a processor causes a processor to carry out several processes are functions, namely, (1) receiving an

electronic message including hard copy output engine configuration data from an undesignated website through a firewall and (2) configuring a hard copy output engine using the configuration data.

The Specification enables this invention. As noted above, claims 8 comprises functional claim language. One of ordinary skill in the art would understand how to configure a device to provide computer instructions for carrying out the recited functions. Moreover, Paragraph [0028] of the Specification provides an enabling disclosure by providing an example of such a device. Paragraph [0028], as originally filed, recites:

[0028] The hard copy output engine 14 includes a controller 20, such as a conventional microprocessor or microcontroller. The hard copy output engine 14 also includes one or more sensors 22 coupled to the controller 20 and a memory 24 in data communication with the controller 20. In one embodiment, the memory 24 comprises conventional volatile and non-volatile memory units. In one embodiment, the memory 24 includes a magnetic, magneto-optic or optical storage media, such as conventional disc storage or floppy disc data storage units, memory integrated circuits or CD-ROMs or the like. In one embodiment, the hard copy output engine 14 accepts instructions as a computer instruction signal embodied in a carrier wave carrying instructions executable by the controller 20.

Clearly, memory 24 falls under the plain meaning of a "device." Clearly, a disk storage or floppy disk data storage unit, described as examples in Paragraph [0028], are known to those of ordinary skill in the art. Computer programmers or software programmers would clearly understand how to create software code for providing instructions that direct a processor to carry out the noted functions. One of ordinary skill in the art would clearly know how to write or otherwise provide such instructions on the disk storage or floppy disk data storage unit.

The Examiner's rejection appears to be solely based on the argument that claims 8 and 10-13 broadly recite a "device" and that the specification does not

enable every kind of "device" that may fall under this broad claim term such as "non-vendor-maintained databases, intermediate transmission media in a network, and other computer systems". However, this is not the law. The law does not require the specification to describe every possible embodiment encompassed by a claim limitation. The law only requires that an enabled example supporting the broader claim limitation be set forth in the specification.

The mere fact that the claim does not specifically recite that the recited device comprises a memory or that device comprises a disk storage or floppy disk data storage unit (the examples in the Specification) does not render the claim invalid under 35 USC 112, first paragraph. The mere fact that claim 1 uses a claim limitation that is broad so as to potentially encompass other examples or embodiments not specifically described in the specification does not render the claim invalid under 35 USC 112, first paragraph. In the present case, the "device" configured to provide the computer construction could also comprise a hardwired memory device or circuitry, or possibly the devices noted by the Examiner. However, to require the rejected claims to specifically recite that the device comprises a disk or floppy disk data storage unit, as described in the specification, would be unnecessary and unduly limiting. Accordingly, the rejection of the claims under 35 USC 112, first paragraph is improper and should be withdrawn.

IV. Rejection of Claims 1, 2, 8 and 10-13 under 35 USC 112, Second Paragraph

Section 8 of the Office Action rejected claims 1, 2, 8 and 10-13 under 35 USC 112, second paragraph. Applicants respectfully traverse each of the rejections and request that they rejections be withdrawn.

A. Claims 8 and 10-13

Claim 8, from which claims 10-13 depend, recite the device configured to provide a computer instruction signal that when executed by a process causes a processor to carry out several processes are steps including receiving an electronic

message including hard copy output engine configuration data from an undesignated website three firewall and configuring the hard copy output engine using the configuration data.

In rejecting the claims, the Office Action asserts "the functionality disclose in the claim pertains only to the intended use of the signal does not define the device in anyway." This assertion is wrong.

As acknowledged by the Office Action, claim they relate includes functional claim language in that it describes the function (the processes resulting from) the configuration of the device). It is well settled law that:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

(MPEP 2173.05(g)). The Examiner's attempt to ignore valid claim limitations on the assertion that such limitations are merely intended use is improper. Moreover, the rejection of such claims under 35 USC 112, second paragraph is also improper as one of ordinary skill in the art would clearly know how to configure a device to perform the claimed functions. Thus, the rejection should be withdrawn.

B. Claims 1 and 2

The Office Action rejected claim 1 by asserting that "the configuration data" recited in claim 1 lacks antecedent basis. In response, the term "hard copy output engine" is inserted before the term "configuration".

The Office Action rejected claim 2 by asserting that the limitation "the hard copy engine" lacks panacea basis. In response, the term "output" is inserted before the term "engine".

The Office Action further asserted that the limitation "the configuration data" lacks antecedent basis. In response, the terms "hard copy output engine" are inserted before of the term "configuration". Thus, Applicants are request that the rejection of claims 1 and 2 be withdrawn in light of these amendments.

V. Rejection of Claims 1-8, 10-16, 18-23 and 25-35 under 35 USC 103(a)
Based upon Kageyama and Ishizuka

Section 10 of the Office Action rejected claims 1-8, 10-16, 18-23 and 25-35 under 35 USC 103(a) as being unpatentable over Kageyama US Patent 6,333,790 in view of Ishizuka US Patent Publication 2002/0065873. For the following reasons, such rejections should be withdrawn.

A. Claim 1

Claim 1 recites a method of configuring a hard copy output engine. The method includes receiving an electronic message including hard copy output engine configuration data from an undesignated web site through a firewall and configuring the hard copy output engine using the configuration data. The data transmitted through the firewall designates a hard copy output engine to be configured.

Neither Kageyama nor Ishizuka, alone or in combination, disclose a method which includes receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall and configuring the hard copy output engine using the configuration data. In contrast, Kageyama merely discloses a printing system in which an updated program and data for a print controller of a printer controlled by a first computer and stored on a second computer is transmitted to the first computer over a network. Ishizuka merely discloses a system by which a wireless mobile device may transmit data or files to be printed over a computer network.

In rejecting claim 1, the Office Action mischaracterizes what is actually taught by Kageyama and Ishizuka. The Office Action states:

Kageyama teaches: receiving an electronic message including hard copy output engine configuration data from an undesignated website, wherein the electronic message designates a hard copy output engine to be configured; and configuring the hard copy output engine using the configuration data (line 13-41 of the column 3 and lines 33-57 of the column 15).

(Office Action dated May 29, 2007, p. 4).

However, this is incorrect. Kageyama does not disclose receiving an electronic message. Kageyama does not disclose receiving an electronic message including hard copy output engine configuration data. Kageyama does not disclose receiving an electronic message including hard copy output engine configuration data from an undesignated website. Nowhere in line 13-41 of column 3 or lines 33-57 of column 15 is an electronic message ever mentioned. Nowhere in the cited portion of Kageyama is an electronic message containing configuration data ever mentioned. Moreover, as Kageyama is limited to interconnected computers and printers on a network, nowhere does Kageyama disclose that the electronic message including the hard copy output engine configuration data is from an undesignated website.

Ishizuka does not satisfy these deficiencies of Kageyama. In fact, Ishizuka says nothing about configuring a hard copy output engine. Rather, Ishizuka solely pertains to method for transmitting data from a wireless device to a printer on a network for printing.

Moreover, even assuming, arguendo, that would be obvious to modify Kageyama based upon Ishizuka, the resulting hypothetical combination would not result in the method recited in claim 1. Rather, the resulting hypothetical combination, at most, would result in the printer of Kageyama being configured using the method disclosed by Kageyama, wherein the printer receives data files to be printed from a wireless device using the method disclosed by Ishizuka. Nothing in Kageyama or Ishizuka provides any motivation for the selective picking and choosing of features so as to result in the method recited in claim 1. Any such

assertion would appear to be based upon impermissible hindsight reasoning using Applicants' own disclosure as a blueprint for such selective modification of Kageyama based upon Ishizuka. Accordingly, the rejection of claim 1 should be withdrawn.

B. Claims 2, 8, 15, 20 and 22

Claim 2 depends from claim 1 and recites that the electronic message comprises an e-mail in that the hard copy output engine includes an embedded Web server that configures a hard copy output engine using the configuration data. As defined in the Specification, the term "Web server" refers to a specialized program running on a server that supports TCP/IP protocol. (See page 7, lines 15-16).

Claim 8 recites an apparatus which includes a device configured to provide a computer instruction signal that when executed by a processor causes a processor to receive an electronic message, comprising an e-mail, including hard copy output engine configuration data from an undesignated website through a firewall and to further configure the hard copy output engine using the configuration data with an embedded Web server contained in the hard copy output engine.

Claim 15 depends from claim 14 and recites that the processing circuitry employs a software module to configure the hard copy an output engine with an embedded Web server contained in the hard copy output engine.

Claim 22 depend from claim 21 and recites that the computer readable code is configured to cause a processor to configure the hardcopy output engine via an embedded Web server contained in the hard copy output engine using the configuration data.

Claim 20 depend from claim 14 and recites that the processing circuitry is configured to employ the software module to configure the hard copy output engine via the embedded Web server and to set threshold for elements chosen from a

group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets are print media consumed.

Neither Kageyama nor Ishizuka, alone or in combination, disclose receiving an e-mail including hard copy output engine configuration data. Neither Kageyama nor Ishizuka, alone or in combination, disclose a hard copy output engine including an embedded Web server that configures the hard copy output engine using the configuration data. In rejecting claim 2, the Office Action refers to column 3, line 13-41 of Kageyama. However, not once in line 13-41 of column 3 of Kageyama is an "e-mail" ever mentioned. Moreover, nowhere does the cited portion of Kageyama ever describe an e-mail that includes hard copy output engine configuration data or an embedded Web server.

Likewise, Ishizuka also does not disclose receiving an e-mail including hard copy output engine configuration data and configuring a hard copy output engine using an embedded Web server using the configuration data. Although Ishizuka discloses a print server 413, Ishizuka does not appear to disclose a Web server. The data received by print server 413 is not hardcopy output engine configuration data. Accordingly, the rejection of claims 2 and 8 should be withdrawn for this additional reason. Claims 10-13 depend from claim 8 and overcome the rejection for the same reasons.

C. Claims 3

Claim 3 depends from claim 1 and recites that receiving the electronic message comprises receiving an e-mail.

As noted above with respect to the rejection of claim 2, neither Kageyama nor Ishizuka disclose receiving an e-mail which includes hard copy output engine configuration data. Accordingly, the rejection of claim 3 should be withdrawn for this additional reason.

D. Claims 4, 11, 14 and 21

Claim 4 depend from claim 1 and recites that receiving the electronic message comprises receiving an e-mail at a first user station and forwarding e-mail to the hard copy output engine.

Claim 11 depends from claim 8 further recites that the instructions cause a processor to receive an e-mail to the firewall a first user station and to forward e-mail to the hard copy output engine.

Claim 14 recites a computer implemented control system for a hard copy output engine. The system includes processing circuitry configured to employee a software module of memory to let printable one) receive an electronic message including hard copy output engine configuration from an undesignated website through a firewall and to configure the hard copy output engine using the configuration data. The processing circuitry further configured to receive an e-mail through the firewall in a first user station and before the e-mail to the hard copy output engine.

Claim 21 recites an article of manufacture comprising a computer usable medium having computer readable code embodied therein is configured to cause a processor to (1) to receive an electronic message including hard copy output engine configuration data from a website through a firewall and to configure the hard copy output engine using the configuration data. The code is further configured to cause a processor to receive an e-mail to the firewall a first user station in the fourth e-mail to the hard copy output engine.

As noted above, neither Kageyama nor Ishizuka disclose receiving an e-mail, let alone, forwarding an e-mail to a hard copy output engine. Thus, the rejection of claims 4, 14 and 21 should be withdrawn for this additional reason. The rejection of claims 15-16 and 18-20, which depend from claim 14 should also be withdrawn. The rejection of claims 22-23 and 25-26, which depend from claim 21 should be withdrawn for at least the same reasons.

E. Claims 5 and 26

Claim 5 recites that receiving an electronic message comprises receiving an XML script and configuring includes setting a threshold for an element chosen from a group consisting of pigmentation material, marking material, number of hours of operation and number of sheets are print media consumed.

Claim 26 depends from claim 21 and recites that the computer readable code is configured to cause a processor to receive the electronic message comprising an XML script including the hardcopy output engine configuration data.

Neither Kageyama nor Ishizuka disclose receiving an electronic message comprising XML script including hard copy output engine configuration data. As acknowledged by the Office Action, Kageyama does not disclose receiving an XML script. As a result, the Office Action attempts to additionally rely upon Ishizuka. However, Ishizuka only discloses receiving an XML file including data that is to be printed. Nowhere does Ishizuka come close to suggesting that the XML file may include configuration data, let alone thresholds for the claimed elements.

The Office Action asserts that simply because Ishizuka discloses the receipt of XML files, "one reporter skill in the art at the time of the applicant's invention would have been motivated to receive the electronic message as an XML script in the system as taught by Kageyama."

However, as noted above, Kageyama fails to disclose receiving an electronic message. Moreover, simply because Ishizuka discloses a printer that receives XML files to be printed would not lead one of ordinary skill in the art to somehow modify Kageyama to receive XML script for configuring a printer. As noted above, at most, Ishizuka would merely lead one of ordinary skill in the art to enable the printer to receive XML files to be printed. Accordingly, the rejection of claims 5 and 26 should be withdrawn for this additional reason.

F. Claims 27-35

The Office Action rejected claims 27-35 based upon Kageyama and Ishizuka by simply asserting that:

Claims 27-35 contain limitations similar to those disclose in claim 01-7 and a rejected under the same rationale.

(Office Action dated May 29, 2007, p. 7).

However, this is not true. Claim 27 and 35 contain distinct and different limitations. For example, claim 27 recites "forming hardcopy output engine configuration on a first side of a firewall based upon input received from a second side of the firewall." (Emphasis added). Claim 32 recites that the hardcopy output engine configuration data "designate a website on the first side of the firewall as a contact for the hardcopy output engine, wherein the website was not previously designated to the hardcopy output engine." Claim 34 recites that step for providing input comprises "interacting with a website on the first side of firewall with a web browser on the second side of the firewall."

Neither Kageyama nor Ishizuka disclose such limitations. The Office Action has failed to assert where Kageyama and Ishizuka allegedly discloses such limitations. The Office Action has failed to establish a prima facie case of obviousness with respect to each of claims 27-35.

Moreover, none of these limitations is found in claim 1-7. Accordingly, the Office Action is incomplete as failing to address each of the limitations of claims 27-35.

37 CFR 1.104 recites

(a) *Examiner's action.*

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to

compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

....

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) *Rejection of claims.*

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(Emphasis added).

Unless such claims are subsequent indicated as being allowable in the next communication, Applicants respectfully request that any subsequent office action be made non-final to allow Applicants a fair opportunity to respond to any subsequent

rejections of claims 27-35 which properly address each of the limitations of claims 27-35.

III. Conclusion.

Claims 1-8, 10-16, 18-23 and 25-35 are now pending in this application.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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By Todd A. Rathe

RATHE PATENT & IP LAW
Customer No. 22879
Telephone: (262) 478-9353
Facsimile: (262) 238-1469

Todd A. Rathe
Attorney for Applicant
Registration No. 38,276